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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: Laureate Learning Systems, Inc.

Serial No.: 76/226,904

Applicant: Laureate Learning Systems, Inc.

Application Filed: March 20, 2001

Mark: LAUREATE

Atty/Docket No: B08208-00005

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451.

Peter K

5/12/05

Signature

Date

Peter B. Kunin, Esq.

(type or print name of person certifying)

Box TTAB
NO FEE

Burlington, Vermont
05402-0190

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

May 12, 2005

TRANSMITTAL LETTER

Enclosed is a Request for a Suspension and Remand of Application in the Ex Parte

Appeal for the above-identified trademark application.

Respectfully submitted,

DOWNS RACHLIN MARTIN PLLC
Attorneys for Applicant

By: Peter K

Peter B. Kunin, Esq.

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BTV.438564.1

05-17-2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re: Laureate Learning Systems, Inc.

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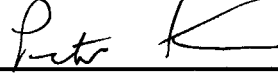
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P.O. Box 1451
Alexandria, VA 22313-1451

May 12, 2005

REQUEST FOR SUSPENSION AND REMAND OF APPLICATION

Applicant, pursuant to Trademark Rule 2.142(d), hereby requests that action on this appeal be suspended and that the application be remanded to the Examining Attorney for consideration of additional evidence attached hereto.

As grounds in support of this request for suspension of action on the appeal and remand of the application, Applicant asserts that it has recently entered into a Consent and Co-Existence Agreement (the "Consent Agreement") with Laureate Education, Inc., the owner of the mark LAUREATE, U.S. Registration No. 1,508,958. The Examining Attorney refused registration of Applicant's application for the above-referenced mark based on a likelihood of confusion with

U.S. Registration No. 1,508,958. The Consent Agreement bears directly on the issue of the likelihood of confusion that is the basis for the refusal of registration in this case. A copy of the Consent Agreement is attached hereto as Exhibit 1.

Generally, under the terms of the Consent Agreement, Laureate Education, Inc. consents to Applicant's use and registration of the LAUREATE mark to identify the goods set forth in the LAUREATE application and agrees to take no action to interfere with Applicant's use or registration of the LAUREATE mark. Pursuant to the Consent Agreement, Applicant and Laureate Education, Inc. acknowledge and agree to the following:

1. Applicant has used its LAUREATE mark to identify its special needs educational software since 1982 and Laureate Education, Inc., through its predecessor in interest, has used its mark LAUREATE to identify the goods and services listed in United States Trademark Registration No. 1,508,958 since 1985. The parties are not aware of any instances of confusion between their respective uses of marks comprised in whole or in part of the term LAUREATE.
2. Applicant and Laureate Education, Inc. believe that they are using their marks in different channels of trade, and that the Consent Agreement helps ensure that they will continue to use their marks in different channels of trade. Specifically, Applicant uses its LAUREATE mark to identify software for children and adults with diagnosed disabilities and other special needs, but Applicant does not and will not use its LAUREATE mark to identify goods and services relating to the provision of post-secondary educational services, except for (i) continuing professional education services (not for college or graduate school credit) in fields of communication, communication disorders, and communication science; (ii) and sales of software to universities and other post-secondary institutions. Laureate Education, Inc. uses its LAUREATE mark to identify goods and services relating to the provision of post-secondary educational services, but Laureate Education, Inc. does not and will not use its LAUREATE mark to identify software for children and adults with diagnosed disabilities and other special needs.
3. Applicant and Laureate Education, Inc. believe that the limitations imposed by the Consent Agreement will allow the parties' respective marks to continue to co-exist without any likelihood of confusion.
4. In the event either Applicant or Laureate Education, Inc. becomes aware of any actual confusion among their respective customers or dealers, both Applicant and Laureate Education, Inc. agree to notify the other and to work together in good faith to alleviate the source of any such actual confusion.

In likelihood of confusion cases, the most compelling evidence that an applicant can introduce into the record is the owner's (of the cited registration) consent to use and registration of the applicant's mark. The Trademark Trial and Appeal Board and the Court of Appeals for the Federal Circuit have found this evidence to be entitled to great weight and, if such consent can be obtained, it will often ensure that the Examiner withdraws the refusal to register. See Krugman, TRADEMARK TRIAL AND APPEAL BOARD PRACTICE AND PROCEDURE, § 2:41 (2005) (citing In re the Port Authority of New York, 3 U.S.P.Q.2d 1453 (TTAB 1987) and In re Omaha Nat. Corp., 819 F.2d 1117 (Fed. Cir. 1987)). The Second Circuit has also found that

[T]rademark agreements are favored in the law as a means by which parties agree to market products in a way that reduces the likelihood of consumer confusion and avoids time consuming litigation. . . . At the time of the execution of such an agreement, the parties are in the best position to determine what protections are needed . . .

Clorox Co. v. Sterling Winthrop, Inc., 117 F.3d 50, 60 (2d Cir. 1997).

In view of the foregoing, it is submitted that fairness requires that this newly available additional evidence be considered by the Examining Attorney prior to this case being decided by the Board on appeal. Accordingly, since the evidence was not in existence prior to the appeal and because the evidence will bear on the issue of likelihood of confusion present in this case, it is respectfully requested that action on this appeal be suspended and that the application be remanded, pursuant to Trademark Rule 2.142(d), for consideration of the additional evidence.

Respectfully submitted,

DOWNS RACHLIN MARTIN PLLC
Attorneys for Applicant

Dated: May 12, 2005

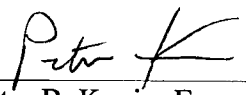
By: 
Peter B. Kunin, Esq.
(802) 863-2375
pkunin@drm.com

EXHIBIT 1

Consent and Co-Existence Agreement

This Consent and Co-Existence Agreement ("Agreement") is made as of this 21st day of April, 2005 ("Effective Date") by and between Laureate Education, Inc. a Maryland Corporation with its address at 1001 Fleet Street Baltimore, Maryland 21202-4382 ("Laureate"), and Laureate Learning Systems, Inc., having a mailing address at 110 East Spring Street, Winooski, Vermont 05404 ("LLS").

Preliminary Statement

Laureate is the owner of United States Trademark Registration No. 1,508,958 for the mark LAUREATE to identify (i) educational books containing reference materials, supplementary materials, and discourse on the nature of learning and on the instruction of others with learning problems, in International Class 16; and (ii) educational services, namely, providing specialized instruction to others in the fields of remedial reading, writing, and mathematics, and study strategies, through the operation of schools; educational consulting services, in International Class 41 (hereinafter referred to as the "LAUREATE Registration").

Laureate is also the owner of U.S. Trademark Application Serial No. 76/566476 for the mark LAUREATE, U.S. Trademark Application Serial No. 76/566475 for the mark LAUREATE INTERNATIONAL UNIVERSITIES, U.S. Trademark Application Serial No. 76/612711 for the mark LAUREATE ONLINE INTERNATIONAL, and U.S. Trademark Application Serial No. 76/617,376 for the mark LAUREATE ONLINE EDUCATION

Laureate uses the trademark LAUREATE both by itself and together with other terms or designations in connection with offering post-secondary educational services, and related products, throughout the world.

LLS is the owner of United States Trademark Application No. 76/226,904 for the mark LAUREATE to identify educational software for children and adults with diagnosed disabilities, consisting of children diagnosed with mental retardation, hearing impairments (including deafness), speech or language impairments, visual impairments (including blindness), serious emotional disturbance, orthopedic impairments, autism, or traumatic brain injury and adults diagnosed with developmental disabilities, aphasia, or closed head trauma; namely interactive applications software providing instruction, through direct intervention, in the fields of language, cognition, auditory processing, and reading, in International Class 9 (hereinafter referred to as the "LAUREATE Application").

LLS is also the owner of United States Trademark Application No. 76/226,911 for the mark LAUREATE LEARNING SYSTEMS to identify educational software for children and adults with diagnosed disabilities, consisting of children diagnosed with mental retardation, hearing impairments (including deafness), speech or language impairments, visual impairments (including blindness), serious emotional disturbance, orthopedic impairments, autism, or traumatic brain injury and adults diagnosed with developmental disabilities, aphasia, or closed head trauma; namely interactive applications software providing instruction, through direct intervention, in the fields of language, cognition, auditory processing, and reading, in International Class 9 (hereinafter referred to as the "LAUREATE LEARNING SYSTEMS Application").

The parties enter into this Consent and Co-Existence Agreement to set forth the terms and conditions under which they will use, register and maintain registrations for these trademarks.

LLS uses the trademark LAUREATE both by itself and together with other terms or designations in connection with computer software products specifically designed to improve the lives of children and adults with diagnosed disabilities resulting in special educational needs. This software is offered worldwide.

Agreement. For good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the parties agree as follows:

1. LLS agrees that it will not use or attempt to register the trademarks LAUREATE, LAUREATE LEARNING SYSTEMS and LAUREATE LEARNING to identify any goods and services relating to post secondary education. The foregoing shall not, however, prohibit LLS from continuing to (i) provide continuing professional education services (not for college or graduate school credit) in the fields of communication, communication disorders, and communication science; and (ii) sell software to universities and other post-secondary institutions. LLS agrees that it will not use the marks LAUREATE INTERNATIONAL UNIVERSITIES, LAUREATE ONLINE INTERNATIONAL and LAUREATE ONLINE EDUCATION.

2. Laureate hereby consents to LLS' use and registration of the marks LAUREATE, LAUREATE LEARNING SYSTEMS and LAUREATE LEARNING to identify the goods set forth in the LAUREATE application and the LAUREATE LEARNING SYSTEMS application, namely "educational software for children and adults with diagnosed disabilities, consisting of children diagnosed with mental retardation, hearing impairments (including deafness), speech or language impairments, visual impairments (including blindness), serious emotional disturbance, orthopedic impairments, autism, or traumatic brain injury and adults diagnosed with developmental disabilities, aphasia, or closed head trauma; namely interactive applications software providing instruction, through direct intervention, in the fields of language, cognition, auditory processing, and reading." Laureate agrees to take no action to interfere with LLS' use or registration of the marks LAUREATE, LAUREATE LEARNING SYSTEMS and LAUREATE LEARNING to identify those goods.

3. Laureate agrees not to use its trademark LAUREATE either by itself or together with other terms or designations to identify goods of the type described and listed in the LAUREATE application or the LAUREATE LEARNING SYSTEMS application. Laureate further agrees not to use the trademarks LAUREATE LEARNING and LAUREATE LEARNING SYSTEMS.

4. LLS consents to Laureate's use and registration of the marks LAUREATE, LAUREATE INTERNATIONAL UNIVERSITIES, LAUREATE ONLINE INTERNATIONAL, LAUREATE ONLINE EDUCATION and other marks comprised in part of the term LAUREATE to identify goods and services relating to the provision of post-secondary educational services. LLS agrees to take no action to interfere with Laureate's use and registration of such marks to identify those goods and services.

5. LLS agrees not to use its trademarks LAUREATE, LAUREATE LEARNING and LAUREATE LEARNING SYSTEMS to identify a school, university, or any goods and services relating to the provision of post-secondary educational services, except for (i) continuing professional education services (not for college or graduate school credit) in fields of

communication, communication disorders, and communication science; (ii) and sales of software to universities and other post-secondary institutions.

6. LLS has used its marks LAUREATE and LAUREATE LEARNING SYSTEMS to identify its special needs educational software since 1982. Laureate, through its predecessor in interest, has used its mark LAUREATE to identify the goods and services listed in United States Trademark Registration No. 1,508,958 since 1985. The parties are not aware of any instances of confusion between their respective uses of marks comprised in whole or in part of the term LAUREATE.

7. The parties believe that they are using their marks in different channels of trade, and that this Agreement helps ensure that they will continue to use their marks in different channels of trade. Specifically, LLS uses its marks LAUREATE, LAUREATE LEARNING and LAUREATE LEARNING SYSTEMS to identify software for children and adults with diagnosed disabilities and other special needs, but LLS does not and will not use its marks LAUREATE, LAUREATE LEARNING and LAUREATE LEARNING SYSTEMS to identify goods and services relating to the provision of post-secondary educational services, except for (i) continuing professional education services (not for college or graduate school credit) in fields of communication, communication disorders, and communication science; (ii) and sales of software to universities and other post-secondary institutions. Laureate uses its mark LAUREATE and other marks that include the term LAUREATE to identify goods and services relating to the provision of post-secondary educational services, but Laureate does not and will not use its mark LAUREATE and other marks that include the term LAUREATE to identify software for children and adults with diagnosed disabilities and other special needs.

8. The parties believe that the limitations imposed by this consent agreement will allow the parties' respective marks to continue to co-exist without any likelihood of confusion.

9. In the event either party becomes aware of any actual confusion among their respective customers or dealers, each party agrees to notify the other and to work together in good faith to alleviate the source of any such actual confusion.

10. Consistent with the other provisions of this Agreement, upon the request of either party, each party agrees to promptly provide the other with such consents to registration and use in such form as may be reasonably requested by the requesting party as may be required to secure registration of a party's mark in any country or countries in which such a consent is deemed necessary by the authorities of such country or countries.

11. The parties each warrant that they have the full power, authority and legal right to execute, deliver and perform the terms of this Agreement, that there is no other person, entity or court whose consent is necessary to make this Agreement fully effective, and that this Agreement has been duly authorized by all necessary corporate action and shall constitute a valid and binding obligation of the respective parties hereto and is enforceable in accordance with its terms.

12. The foregoing constitutes the full and complete agreement between the parties with respect to the subject matter hereof, or contemplated hereby, and there are no other oral or written agreements in relation to the subject matter of this Agreement, except as expressly provided for herein. The Parties have not relied on any representations or agreements of the other Party hereto which are not embodied herein.

13. This Agreement may be executed in any manner of multiple originals by different parties hereto, each of which shall be deemed to be an original and all of which shall constitute collectively one agreement. In making proof of this Agreement, it shall not be necessary to produce or account for more than one such fully executed counterpart.

14. The parties agree that upon the request of any one of them, they will execute and deliver such further documents and undertake such further action as may reasonably be required to effect any of the agreements and covenants contained in this Agreement.

15. In case any one or more provisions or portions hereof is determined to be invalid, illegal or unenforceable in any respect, the validity, legality and enforceability of the remaining provisions contained herein shall not in any way be affected or impaired thereby.

16. This Agreement shall be governed by, construed under and be enforceable in accordance with the laws of the State of Maryland, without regard to conflicts-of-laws principles. All claims and disputes between the parties arising out of or relating to this Agreement shall be exclusively resolved in the federal courts in Maryland, and both parties consent to the exclusive personal jurisdiction and venue of the federal courts of Maryland for said purpose.

17. This Agreement shall be binding upon and inure to the benefit of the parties, and their respective heirs, representatives, successors, and permitted assigns.

18. The parties agree that they have read this Agreement and have had their rights fully explained by their attorneys; that they have been advised by their attorneys that it is a fair and reasonable settlement; and that they have been advised by their attorneys to execute the Agreement.

19. If one or more disputes arise with regard to the interpretation and/or performance of this Agreement or any of its provisions, the parties agree to attempt to resolve same through a mutually agreed-upon mediator. If the parties cannot resolve their differences by a telephone mediation conference, then the parties agree to schedule one day of mediation as soon as possible to resolve the disputes. The parties agree to share the costs of mediation equally. If a party refuses to mediate, that party may not recover attorney's fees or costs in any litigation brought to construe or enforce this agreement. Otherwise, if mediation is not successful and litigation is brought to construe, enforce, or seek restitution in connection with the obligations, warranties, and indemnities of this Agreement, the prevailing party shall be entitled to recover reasonable attorney's fees, costs and expenses, including the cost of the unsuccessful mediation.

20. The parties agree that the remedy at law for any act or event that constitutes a default under this Agreement will be inadequate and that in addition to the remedy at law, the parties shall be entitled to injunctive relief, specific performance or other such equitable relief.

IN WITNESS WHEREOF, the parties have caused this Consent and Co-Existence Agreement to be executed as of the date first written above.

LAUREATE LEARNING SYSTEMS, INC.

By: Mary J. Wilson

Printed Name: Mary J. Wilson

Title: President

Date: April 21, 2005

LAUREATE EDUCATION, INC.

By: Robert W. Zentz

Printed Name: Robert W. Zentz

Title: Sr. V.P.

Date: April 22, 2005

RTV 307218.6